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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,503	09/21/2001	Anuj Aggarwal	24320	5346

20529 7590 06/26/2006

NATH & ASSOCIATES
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EXAMINER	
BOYD, JENNIFER A	

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 06/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/831,503	AGGARWAL ET AL.	
	Examiner	Art Unit	
	Jennifer A. Boyd	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The Applicant's Amendments and Accompanying Remarks, filed March 22, 2006, have been entered and have been carefully considered. Claims 1 and 12 are amended and claims 1 and 3 – 21 are pending. In view of Applicant's amendments, the Examiner has amended the previously applied rejections as detailed below. The invention as currently claimed is unpatentable for reasons herein below.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102/103

3. Claims 1, 3 - 4, 8 – 9 and 12 – 19 remain rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Romesberg et al. (US 5,582,906). The details of the rejection can be found in the Office Action dated 9/22/05. The rejection is maintained.

In regards to the newly introduced limitation in claims 1 and 12 of "and selected to optimize an acoustic effectiveness of the lining by selecting the air flow resistance so as to provide sound absorption coefficients which are sufficient to provide sound absorption at a predetermined low frequency while providing sound absorption coefficients at higher frequencies sufficiently low as to facilitate intelligibility of speech in the passenger compartment when combined with the sound absorption at the predetermined low frequency", it should be

noted that the Examiner has not given the amendment patentable weight because claim scope is not limited by claim language that suggests or makes optional but does not require the steps to be performed, or by claim language that does not limit a claim to a particular structure. The limitation claims the intended result of a product/process rather than the actual product/process. See MPEP 2111.04. Additionally, in regards to claim 1, it should be noted that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or an obvious variant from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the Applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983).

Claim Rejections - 35 USC § 103

4. Claims 1, 5 – 8, 10 and 20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Rozek et al. (US 6,204,209) in view of Doerfling et al. (US 3,935,353) and Sandoe et al. (US 2001/0036788 A1). The details of the rejection can be found in the Office Action dated 9/22/05. The rejection is maintained.

In regards to the newly introduced limitation in claim 1 of "and selected to optimize an acoustic effectiveness of the lining by selecting the air flow resistance so as to provide sound absorption coefficients which are sufficient to provide sound absorption at a predetermined low frequency while providing sound absorption coefficients at higher frequencies sufficiently low as

to facilitate intelligibility of speech in the passenger compartment when combined with the sound absorption at the predetermined low frequency", it should be noted that the Examiner has not given the amendment patentable weight because claim scope is not limited by claim language that suggests or makes optional but does not require the steps to be performed, or by claim language that does not limit a claim to a particular structure. The limitation claims the intended result of a product/process rather than the actual product/process. See MPEP 2111.04. Additionally, in regards to claim 1, it should be noted that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or an obvious variant from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the Applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983).

4. Claim 11 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Romesberg et al. (US 5,582,906), as set forth above, taken in view of Blum et al. (US 4,581,432). The details of the rejection can be found in the Office Action dated 9/22/05. The rejection is maintained.

5. Claim 21 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Romesberg et al. (US 5,582,906). The details of the rejection can be found in the Office Action dated 9/22/05. The rejection is maintained.

Response to Arguments

5. Applicant's arguments filed June 30, 2005 have been fully considered but they are not persuasive.

Applicant argues that Romesberg et al. and Rozek et al. (US 6,204,209) in view of Doerfling et al. (US 3,935,353) and Sandoe et al. (US 2001/0036788 A1) do not disclose the newly added limitation of "and selected to optimize an acoustic effectiveness of the lining by selecting the air flow resistance so as to provide sound absorption coefficients which are sufficient to provide sound absorption at a predetermined low frequency while providing sound absorption coefficients at higher frequencies sufficiently low as to facilitate intelligibility of speech in the passenger compartment when combined with the sound absorption at the predetermined low frequency". It should be noted that the Examiner has not given the amendment patentable weight because claim scope is not limited by claim language that suggests or makes optional but does not require the steps to be performed, or by claim language that does not limit a claim to a particular structure. The limitation claims the intended result of a product/process rather than the actual product/process. See MPEP 2111.04. Additionally, in regards to claim 1, it should be noted that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or an obvious variant from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the Applicant to

show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983).

Applicant argues that Sandoe fails to teach the use of an air-impermeable back layer. The Examiner submits that the roof serves as the air-impermeable back layer. The Applicant has failed to provide any additional details that would further differentiate Applicant's "air impermeable back layer" from Sandoe's roof. Furthermore, the claim language does not preclude the use of the roof as the air-impermeable back layer.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A. Boyd whose telephone number is 571-272-1473. The examiner can normally be reached on Monday thru Friday (8:30am - 6:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jennifer Boyd
June 20, 2006

Ula C. Ruddock
Primary Examiner
Tech Center 1700